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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/775,692      | 02/10/2004  | Knut M. Schwarz      | H-1351 CIP          | 9187             |

7590  
William W. Jones  
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09/11/2006

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| EXAMINER |
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CHAN, KO HUNG

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| ART UNIT | PAPER NUMBER |
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3632

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/775,692 | <b>Applicant(s)</b><br>SCHWARZ ET AL. |  |
|                              | <b>Examiner</b><br>Korie H. Chan     | <b>Art Unit</b><br>3632               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation of “mechanical arm being sufficient flexible so as bend before the tensile strength of the tissue of a surgical patient is reached during maneuvering of the mechanical arm and seat during surgery” is vague and indefinite. Applicant is setting a limitation of the flexibility of the arm base on the tensile strength of a tissue in a human body where as discussed in applicant’s specification such “tensile strength” varies with age. To use such wide spectrum of “tensile strengths” to define the flexibility of applicant’s claimed mechanical arm is vague and indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Ognier (US patent no. 5,918,844). Ognier discloses a holding and positioning assembly for securing surgical accessory instruments in place during surgery, the assembly comprising a swiveling and rotatable seat (105b) for the accessory instruments, the seat including means for gripping the instrument (103) and the seat being linked to a mechanical arm (105a and 106) via a multi-directionally movable joint mechanism (108a, 109), and the mechanical arm being manually maneuverable to alter the position of the seat in the assembly; further, Ognier's mechanical arm is of a ball joint which is known to be rotatable around 360 degrees and which means it is inherently capable of degree of operative motion to a cone having angle of no more than 35 degrees. It would have been a matter of obvious mechanical expedient to have restricted the movement of the mechanical arm to a cone of no more than 35 degrees as Ognier's device is inherently capable of such movement for the purpose intended.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ognier (US patent no. 5,918,844) in view of Osypka (US patent no. 6,684,109). Ognier discloses a holding and positioning assembly for securing surgical accessory

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instruments in place during surgery, the assembly comprising a swiveling and rotatable seat (105b) for the accessory instruments, the seat including means for gripping the instrument (103) and the seat being linked to a mechanical arm (105a and 106) via a multi-directionally movable joint mechanism (108a, 109), the mechanical arm being operative to prevent body cavity wall rupture during orientation of the instrument in the body cavity, and the mechanical arm being manually maneuverable to alter the position of the seat in the assembly; wherein the mechanical arm is sufficiently elastic so as to bend before the tensile strength of the tissue of a surgical patient is reached during maneuvering of the assembly during surgery; the elasticity of the mechanical arm is controlled by the material that the mechanical arm is formed from; wherein the elasticity of the mechanical arm is the result of swiveling joints (108, 108a) formed in the mechanical arm; wherein the swiveling joints are biased by torsion springs (40c, figure 5); wherein rupture of the body cavity wall is prevented by restricting the degree of operative motion of the mechanical arm. Regarding claim 16, Ognier's mechanical arm is of a ball joint which is known to be rotatable around 360 degrees and which means it is inherently capable of degree of operative motion to a cone having angle of no more than 35 degrees. It would have been a matter of obvious mechanical expedient to have restricted the movement of the mechanical arm to a cone of no more than 35 degrees as Ognier's device is inherently capable of such movement for the purpose intended.

However, Ognier does not disclose the arm is of elastic mechanical arm having resilient connectors of elastomeric material or torsion spring.

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Arm of elastic type made of elastomeric material such as torsion spring are old and well-known in the art. Osypka teaches a surgical device having a mechanical arm of elastic type made of elastomeric material such as torsion spring (col. 7, lines 58-60, 312, figure 6) to better aid in the active deployment of the arms from a constrained position to an unstressed deployed position (col. 7, lines 53-55). It would have been obvious to one of ordinary skill in the art to have modify the arm and joint of Ognier such that it is of an arm of elastic type made of elastomeric material such as torsion spring to better aid in the active deployment of the arms from a constrained position to an unstressed deployed position as taught to be desirable by Osypka. Such modification would have involved a mere substitution of one well-known type of mechanical arm with another which is thought to be well within the ambit of one of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 11-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571)272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc  
August 28, 2006